

### **REMARKS**

Presently, claims 117-199 are pending in the application. Claims 117, 118, 121, 134, 141, 142, 145, 149, 150, 153, 165, 172, 174, 175, 178, 182, 192, 196, and 197 have been amended. Support for the features of the amendments to claims 117, 118, 121, 141, 142, 145, 149, 150, 153, 165, 172, 174, 175, 178, 182, 192, 196, and 197 may be found, for example, at page 8, lines 7 – 12 and at page 13, lines 14 – 30 of the specification. Claim 134 has been amended to correct a formal error noted by Applicants. Accordingly, no new matter has been added to the application by the foregoing amendments.

### ***Examiner Interview***

Applicants and the undersigned thank Examiner Lonsberry for the courtesies extended during a telephone interview conducted on August 8, 2007. During the interview, the Examiner informed Applicants that the previous Final rejection was premature, that a new non-final rejection would be issued, and that no action would be required by Applicants to prevent abandonment.

To prevent the application from going abandoned until a new, non-final rejection could be mailed, Applicants filed a Notice of Appeal of August 9, 2007. In view of the present Office Action, such Appeal has been withdrawn.

### ***Claim Rejections – 35 U.S.C. §103(a)***

### **Patentability over Bryant and Wilkins**

The Examiner has rejected claims 117-119, 122-124, 127-138, 143-144, 146-151, 153-156, 159-165, 167-171 and 192 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,652,615 to Bryant (“Bryant”) in view of U.S. Patent No. 5,446,919 to Wilkins (“Wilkins”).

At page 12 of the Office Action, the Examiner has rejected claims 125, 126, 157, 158 as being unpatentable over Bryant in view of Wilkins and in further view of Wilkins. Applicants are unclear as to how this rejection is different than the foregoing rejection

over Bryant in view of Wilkins. Regardless, Applicants respectfully traverse these rejections, and will address both rejections simultaneously below.

The Examiner contends that Bryant in combination with Wilkins teaches all elements of these claims. In particular, the Examiner acknowledges that Bryant does not clearly disclose “wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup”, but contends that Wilkins teaches this missing element, and concludes that it would have been obvious to modify the Bryant with the teachings of Wilkins to result in Applicants’ claimed invention.

The prior art references, when combined, must teach or suggest all elements of the claims. *See* MPEP 2143. However, even if one were to combine the teachings of Bryant and Wilkins, the resulting combination would still not teach or suggest that which is claimed by Applicants.

Independent claim 117 recites (with emphasis added):

A method for presenting targeted advertisements in a telecom system, the method comprising:

forming a group for the reception of signals for the telecom system;

forming a plurality of subgroups for the group;

assigning a subgroup address to each subgroup;

receiving a program stream;

selecting one or more targeted advertisements for a first subgroup;

assigning an advertisement identifier to each of the targeted advertisements;

creating a relationship between the subgroup address and the one or more advertising identifiers; and

transmitting the program stream and the targeted advertisements selected for the first subgroup to a first set of

receivers corresponding to the first subgroup, wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.

The Examiner concedes that Bryant clearly does not disclose transmitting a program stream and targeted advertisements selected for a first subgroup to the first subgroup, “wherein the first subgroup does not receive targeted advertisements corresponding to any other subgroup” (Office Action, page 3). Instead, Bryant teaches a system that distributes a single composite program, containing a base program segment and a fill program segment. Multiple targeted advertisements are included in each fill program segment (see Figs. 3, 6, and 8 of Bryant), with each advertisement in a particular fill segment being selected for a different target audience. Fig. 8 of Bryant demonstrates distribution of a single composite program containing multiple sets of targeted advertisements within a single fill segment. In Fig. 8, the same composite program is delivered to different subscriber groups, where the set-top box selects the appropriate advertisement within the fill segment for presentation to the subscriber. In other words, the households containing STB 832 and STB 833 in Bryant, both receive the same composite program containing multiple sets of targeted advertisements selected for different subscribers from the street box or cable head-end. The set-top box at each respective household determines which of the received targeted advertisements to display. Thus, Bryant alone does not teach or suggest that “a first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.”

Furthermore, Wilkins alone does also not teach or suggest that “a first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” Wilkins teaches a channel switching technique of delivering targeted advertisements. The channel switching is accomplished by a channel selector/decoder located in the home. All the programming channels are received in the home by the channel selector/decoder and one of the three functions of this channel selector/decoder is “switch to the appropriate viewing channel” (column 10, lines 9 – 10). In fact, Wilkins teaches away from an exclusive delivery scheme, since all the

programming channels are received in the home by the channel selector/decoder and one of the three functions of this channel selector/decoder is “switch to the appropriate viewing channel” (column 10, lines 9 – 10). Therefore, the channel selector/decoder of Wilkins does indeed receive targeted advertisements corresponding to other subgroups. Thus, Wilkins alone does not teach or suggest that “a first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup,” as recited in independent claim 117.

Since neither Wilkins nor Bryant, when considered alone, teaches that “a first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” as previously explained, the combination of Bryant and Wilkins cannot possibly teach this feature, as recited in independent claim 117.

Since Bryant and Wilkins, taken alone or in combination, do not teach or suggest all elements of independent claim 117, independent claim 117 is believed to be allowable. Dependent claims 118-119, 122-124, 127-138, 143-144, 146-148 are allowable at least by their dependency on independent claim 117.

Independent claim 149 recites “wherein a first set of the receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant and Wilkins does not teach or suggest all features of independent claim 149. Accordingly, independent claim 149 is believed to be allowable over the combination of Bryant and Wilkins. Dependent claims 150, 151, 154-156, 159-164 are allowable at least by their dependency on independent claim 149.

Independent claim 153 recites “wherein a first set of the receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant and Wilkins does not teach

or suggest all features of independent claim 153. Accordingly, independent claim 153 is believed to be allowable over the combination of Bryant and Wilkins.

Independent claim 165 recites “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup” and “wherein the second set of receivers corresponding to the second subgroup does not receive targeted advertisements corresponding to any other subgroup.” For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant and Wilkins does not teach or suggest all features of independent claim 165. Accordingly, independent claim 165 is believed to be allowable over the combination of Bryant and Wilkins. Dependent claims 167-171 are allowable at least by their dependency on independent claim 165.

Independent claim 192 recites “wherein the first set of receivers corresponding to the first subgroup do not receive targeted advertisements corresponding to any other subgroup”, and “wherein the second set of receivers corresponding to the second subgroup do not receive targeted advertisements corresponding to any other subgroup.” For the same reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant and Wilkins does not teach or suggest all features of independent claim 192. Accordingly, independent claim 192 is believed to be allowable over the combination of Bryant and Wilkins.

Reconsideration and withdrawal of the Examiner’s rejection of claims 117-119, 122-138, 143-144, 146-151, 153-165, 167-171 and 192 are respectfully requested.

For the same reasons discussed above, Applicants respectfully submit that independent claims 117 and 149 are allowable over the combination of Bryant and Wilkins in further view of Wilkins. Applicants respectfully submit that Wilkins does not teach or suggest the missing feature(s). Accordingly, independent claims 117 and 149 are believed to be allowable over the proposed combination of Bryant, Wilkins in further view of Wilkins. Accordingly, dependent claims 125, 126, 157, and 158 are believed to be allowable over the combination of Bryant, Wilkins in further view of Wilkins at least

by their dependency on independent claims 117 and 149, respectively. Reconsideration and withdrawal of the Examiner's rejection of claims 125, 126, 157, 158 are respectfully requested.

**Patentability over Bryant, Wilkins and Lakey**

The Examiner has rejected claims 120, 121, 152, 166, 175-176, and 197 as being unpatentable over Bryant in view of Wilkins and in further view of U.S. Patent No. 6,078,954 to Lakey ("Lakey"). Applicants respectfully traverse this rejection.

When making a rejection under 35 U.S.C. § 103, the Examiner has the burden of establishing a *prima facie* case of obviousness. In *KSR*, the Court stated that it was "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.* 127 S. Ct. 1727 (U.S. 2007). It is important to determine whether there was an "apparent reason to combine the known elements in the fashion claimed by the patent at issue." See *KSR*. The Court noted, "[t]o facilitate review, this analysis should be made explicit." See *KSR*. Therefore, the Examiner must identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed: "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR, citing In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

Neither Bryant, Wilkins, or Lakey explicitly or inherently suggests such a combination, nor has the Examiner pointed to any teaching why it would be apparent to one skilled in the art to make such a combination. Furthermore, it would not make sense to one skilled in the art to combine Lakey with Bryant and/or Wilkins, as the Examiner suggests.

More specifically, Bryant discloses a system for delivery of composite programs to targeted audiences, and Wilkins discloses a system for targeting a demographically or

psychographically defined audience using channel switching in the home by a channel selector/decoder device. Bryant states:

interactive program distribution requires two-way (duplex) communication on the network. Duplex communication ... generally uses more complex and expensive equipment...It is desired to precisely broadcast program signals...without unduly increasing the complexity of extant broadcast networks. (column 2, lines 5-13)

Accordingly, Bryant teaches a unidirectional broadcast network, as indicated in Fig. 1 with a unidirectional flow of content from the head end 140 to the customer premises equipment (CPE) 170. Similarly, Wilkins shows in Figs. 1B and 2 a unidirectional system with respect to the flow of content into the home (reference numeral 99 in Fig. 1B connecting combiner 98 from the head-end to channel selector decoder 100 in the home). It should be noted that , with respect to two way communication, Wilkins teaches “[W]hen combined with the two way capabilities already present in some cable television systems, it will be possible to record what advertising is actually viewed by the household.” (column 6, lines 37-40, emphasis added). Thus, while Wilkins recognizes the possible advantage of a two-way system, Wilkins’ system does not require a two way scheme since Wilkins concedes that not all cable television systems support duplex communication. Therefore, only an embodiment of Wilkins that utilizes unidirectional communication should be considered in combination with Bryant so to not unduly burden the system of Bryant with need for two-way communication.

Lakey is directed to implementing a multicast protocol on a network. The system of Lakey inherently requires two-way (bi-directional) communication between a client and server. For example, “when a client is activated, it notifies the server of its active status” (column 2, lines 12-13). Accordingly, common sense would dictate that one of ordinary skill in the art would not to look to Lakey to solve a problem not present in Bryant or Wilkins, nor to add unnecessary elements not required by Bryant or Wilkins. Stated differently, in essence, the combination of Bryant and Wilkins teaches away from Lakey, since Bryant expressly teaches against using a duplex communication, such as that taught by Lakey, since two-way communication is unduly complex and burdensome.

The Examiner has thus ignored the “Basic Considerations Which Apply to Obviousness Rejections,” that instruct the Examiner that “[t]he references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination,” (see MPEP 2141). Further, MPEP 2141.02 instructs that “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” In view of the foregoing, Applicants respectfully submit that the combination of Bryant, Wilkins, and Lakey is improper.

Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); MPEP § 2143.01.

The combination of Lakey with Bryant and Wilkins would substantially alter the method of operation of the combination of Bryant and Wilkins for the reasons identified above with respect to Bryant teaching away from duplex communication and the necessity of such communication in Lakey. Thus, Lakey would effectively change the principle of operation of Bryant and/or Wilkins, making them duplex communication systems – which they are not – thereby rendering the three references not properly combinable.

Additionally, as discussed above, independent claim 117 is believed to be allowable over the combination of Bryant and Wilkins. Applicants respectfully submit that Lakey does not teach or suggest the feature(s) missing from this combination. Accordingly, independent claim 117 is believed to be allowable over the proposed combination of Bryant, Wilkins and Lakey. Dependent claims 120, 152 and 166 are allowable at least by their dependency on independent claim 117.

Independent claim 121 recites “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant, Wilkins, and Lakey is improper and does not teach or suggest all features of independent claim 121.

Accordingly, independent claim 121 is believed to be allowable over the combination of Bryant, Wilkins, and Lakey.

Independent claim 175 recites “the first subgroup receivers do not receive targeted advertisements corresponding to any other subgroup” and “the second subgroup receivers do not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant, Wilkins, and Lakey is improper and does not teach or suggest all features of independent claim 175. Accordingly, independent claim 175 is believed to be allowable over the combination of Bryant, Wilkins, and Lakey. Dependent claim 176 is allowable at least by its dependency on independent claim 175.

Independent claim 197 recites “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup” and “wherein the second set of receivers corresponding to the second subgroup does not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above with respect to independent claim 117, Applicants respectfully submit that the combination of Bryant, Wilkins, and Lakey is improper and does not teach or suggest all features of independent claim 197. Accordingly, independent claim 197 is believed to be allowable over the combination of Bryant, Wilkins, and Lakey.

Reconsideration and withdrawal of the Examiner’s rejection of claims 120, 121, 152, 166, 175-176, and 197 are respectfully requested.

**Patentability over Bryant, Wilkins and Monteiro**

The Examiner has rejected claims 120, 121, 139-142, 145, 152, 153, 166, 172-191, and 193-199 as being unpatentable over Bryant in view of Wilkins and in further view of U.S. Patent No. 6,078,954 to Monteiro (“Monteiro”). Applicants respectfully traverse this rejection.

Neither Bryant, Wilkins, or Monteiro explicitly or inherently suggests such a combination, nor has the Examiner pointed to any teaching why it would be apparent to one skilled in the art to make such a combination. Furthermore, it would not make sense to one skilled in the art to combine Monteiro with Bryant and/or Wilkins, as the Examiner suggests.

More specifically, as discussed above with respect to the Examiner's rejection over Bryant, Wilkins and Lakey, only an embodiment of Wilkins that utilizes unidirectional communication should be considered in combination with Bryant so to not unduly burden the system of Bryant with need for two-way communication.

Monteiro discloses implementing a multicast protocol on a network. Like Lakey, the system of Monteiro inherently contains two-way (bi-directional) communication between a user and server. For example, "authenticating users who want to log into the system" (column 3, lines 45-46) and "enables the system to monitor which Users are listening to which channels" (column 8, lines 10-11). Figs. 5 – 8 of Monteiro also show two-way communication between a User and server. Accordingly, common sense would dictate that one of ordinary skill in the art would not to look to Monteiro to solve a problem not present in Bryant or Wilkins, nor to add unnecessary elements not required by Bryant or Wilkins. Stated differently, in essence, the combination of Bryant and Wilkins teaches away from Monteiro, since Bryant expressly teaches against using a duplex communication, such as that taught by Monteiro, since two-way communication is unduly complex and burdensome. In view of the foregoing, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper.

Additionally, the combination of Monteiro with Bryant and Wilkins would substantially alter the method of operation of the combination of Bryant and Wilkins for the reasons identified above with respect to Bryant teaching away from duplex communication and the necessity of such communication in Monteiro. Thus, Monteiro would change the principle of operation of a combination of Bryant and/or Wilkins, making them duplex communication systems – which they are not – thereby rendering the three references not properly combinable.

Additionally, as discussed above, independent claims 117, 145 and 153 are believed to be allowable over the combination of Bryant and Wilkins. Applicants respectfully submit that Monteiro does not teach or suggest the feature(s) missing from this combination. Accordingly, independent claims 117, 145 and 153 are believed to be allowable over the proposed combination of Bryant, Wilkins and Monteiro.

Independent claim 121 recites, “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper and does not teach or suggest all features of independent claim 121. Accordingly, independent claim 121 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 141 recites, “transmitting the program stream and only the targeted advertisements selected for the first subgroup to a first set of receivers corresponding to the first subgroup” Similarly, independent claims 142 recites, “wherein the targeted advertisements transmitted to the first set of receivers corresponding to the first subgroup include only targeted advertisements corresponding to the first subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper and does not teach or suggest all features of independent claims 141 and 142. Accordingly, independent claims 141 and 142 are believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 172 recites, “wherein the first set of receivers corresponding to the first subgroup receives targeted advertisements corresponding only to the first subgroup” and “wherein the second set of receivers corresponding to the second subgroup receives targeted advertisements corresponding only to the second subgroup.” Similarly, independent claim 174 recites, “wherein a first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup” and “wherein a second set of receivers corresponding to the second subgroup does not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of

Bryant, Wilkins, and Monteiro is improper and does not teach or suggest all features of independent claims 172 and 174. Accordingly, independent claims 172 and 174 are believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 175 recites “the first subgroup receivers do not receive targeted advertisements corresponding to any other subgroup” and “the second subgroup receivers do not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant and Wilkins, and Monteiro is improper and the combination of Bryant, Wilkins, and Monteiro does not teach or suggest all features of independent claim 175. Accordingly, independent claim 175 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

With respect to independent claim 178, the Examiner has taken Official Notice (see page 16 of the Office Action) that it was “well known in the art to implement channels using the DOCSIS standard so as to allow interoperability.” However, Applicants disagree that there are “facts outside of the record which are capable of instant and unquestionable demonstration as being ‘well-known’ in the art,” as required by M.P.E.P. §2144.03, which would support an Examiner’s finding of Official Notice.

To the extent that the Examiner’s taking of Official Notice may be applied to any of the pending claims, Applicants respectfully traverse the Examiner’s taking of Official Notice, and respectfully request that the Examiner support the taking of Official Notice by producing a relevant reference that shows/teaches implementing channels using the DOCSIS standard so as to allow interoperability, and that the Examiner identify a specific teaching in the reference to support a combination with Bryant.

Independent claim 178 recites, “the first subgroup of client receivers receives targeted advertisements corresponding only to the first subgroup” and “the second subgroup of client receivers receives targeted advertisements corresponding only to the second subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant Wilkins, and Monteiro is improper and the combination of

Bryant, Wilkins, and Monteiro does not teach or suggest all features of independent claim 178. Accordingly, independent claim 178 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 182 recites, “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup” and “wherein the second set of receivers corresponding to the second subgroup does not receive targeted advertisements corresponding to any other subgroup” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper and the combination of Bryant, Wilkins, and Monteiro does not teach or suggest all features of independent claim 182. Accordingly, independent claim 182 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 196 recites, “wherein the first set of receivers corresponding to the first subgroup receive targeted advertisements only corresponding to the first subgroup” and “wherein the second set of receivers corresponding to the second subgroup receive targeted advertisements only corresponding to the second subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper and the combination of Bryant, Wilkins, and Monteiro does not teach or suggest all features of independent claim 196. Accordingly, independent claim 196 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Independent claim 197 recites “wherein the first set of receivers corresponding to the first subgroup does not receive targeted advertisements corresponding to any other subgroup” and “wherein the second set of receivers corresponding to the second subgroup does not receive targeted advertisements corresponding to any other subgroup.” For similar reasons discussed above, Applicants respectfully submit that the combination of Bryant, Wilkins, and Monteiro is improper and does not teach or suggest all features of independent claim 197. Accordingly, independent claim 197 is believed to be allowable over the combination of Bryant, Wilkins, and Monteiro.

Dependent claims 120, 139-140, 152, 166, 173, 176-177, 179-181, 183-191, 193-195 and 198-199 are believed to be allowable at least by their dependency on their respective independent claim. Reconsideration and withdrawal of the Examiner's rejection of claims 120, 121, 139-142, 145, 152, 153, 166, 172-191, and 193-199 are respectfully requested.

*Conclusion*

In view of the foregoing remarks, Applicants respectfully submit that the Examiner's rejections have been overcome, and that the application, including claims 117-199, is in condition for allowance. Reconsideration and withdrawal of the Examiner's rejections and an early Notice of Allowance are respectfully requested.

Respectfully submitted,

Date: 1/30/08

By: Andrew W. Spicer

Andrew W. Spicer  
Registration No. 57,420  
Technology, Patents & Licensing, Inc.  
2003 South Easton Road, Suite 208  
Doylestown, PA 18901  
267-880-1720

Customer Number: 27832